THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte WAYNE R. DAKIN

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Appeal No. 1999-0189
Application 08/344,691

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HEARD: March 22, 2000

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Before STONER, Chief Administrative Patent Judge, and HAIRSTON and Nase, Administrative Patent Judges.

Hairston, Administrative Patent Judge.

This is an appeal from the final rejection of claims 42 through 51, 53 through 59 and 61.

The disclosed invention relates to a method and apparatus for producing a signal used for forming a record disc which stores segments of audio information and corresponding

segments of video information, and to a method and apparatus for reproducing information from a disc which has data recorded thereon of a type which includes a frame of a video signal which is displayed while an audio portion is played.

Claims 42 and 45 are illustrative of the claimed invention, and they read as follows:

42. An apparatus for producing a signal used for forming a record disc which stores segments of audio information and corresponding segments of video information, comprising:

means for receiving a video signal to be recorded and an audio signal to be recorded;

a memory for storing said audio signal during recording;

a video normalizer, receiving an output of said memory, and adjusting a level of said output of said memory to produce a normalized signal which is adjusted relative to a level of said video signal, thereby utilizing a full dynamic range of video circuitry; and

means for combining said normalized signal indicative of audio with said video signal to produce a composite normalized signal.

45. An apparatus for reproducing information from a disc which has data recorded thereon of a type which includes a frame of a video signal which is displayed while an audio portion is played, comprising:

an element which scans said disc to obtain a combined video/data signal, said video/data signal having a video portion and an audio portion normalized relative to said video portion;

an audio normalizer, receiving said video/data signal, adjusting a level of said video/data signal to produce a normalized signal which utilizes a full dynamic range of audio circuitry;

a memory, operatively connected to receive at least a part of said combined video/data signal as normalized by said audio normalizer; and

a data converter, operatively coupled to an output of said memory means, reading out audio information from said memory.

Claims 42 through 51, 53 through 59 and 61 stand rejected "under the judicially created doctrine of double patenting over claims 1-12 of U.S. Patent No. 4,583,131 since the claims, if allowed, would improperly extend the 'right to exclude' already granted in the patent" (Answer, page 3).

Reference is made to the brief and the answer for the respective positions of the appellant and the examiner.

OPINION

The rejection of claims 42 through 51, 53 through 59 and 61 is reversed.

The examiner's statement of the rejection (Examiner's Answer, pages 3 through 5) is reproduced in toto as follows:

> Claims 42-51, 53-59, and 61 are rejected under the judicially created doctrine of double patenting over claims 1-12 of U.S. Patent No. 4,583,131 since the claims, if allowed, would improperly extend the

"right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: an apparatus for reproducing information form [sic, from] a disc which has data recorded thereon of a type which includes a frame of a video signal is display [sic] while an audio portion is played having an element which scans the disc to obtain a combined video/data signal, the video/data signal having a video portion and an audio portion; a memory, operatively connected to receive at least a part of the combined video/data signal; and a data converter, operatively coupled to an output of the memory means, reading out audio information form [sic, from] the memory. The subject matter recited in claims 42-62 of this patent application - "comprising ABCY" - is fully disclosed in the patent 4,583,131. The allowance of these claims would extend the rights [sic] to exclude already granted in claims 1-12 of the patent - that right to exclude covering the device "comprising ABCX". The transitional phrase "comprising" does not exclude the presence of elements other than A, B, C, and X in the claims of the patent. Because of the phrase "comprising" the patent claims not only provides [sic] protection to the elements ABCX claimed in the patent but also extends [sic] patent coverage to the disclosed combination - ABCXY. Like wise [sic], if allowed, the claims of this application, because of the phrase comprising, not only would provide patent protection to the claimed combination ABCY but would also extend patent coverage to the combination ABCXY - already disclosed and covered by the claim in the patent. Thus, the controlling fact is that patent protection for the device, fully disclosed in and covered by the claims of the patent, would be extended by the allowance of the claims in this application.

> Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).[1] See also MPEP § 804.

In response to the examiner's Schneller-based rejection, appellant argues (Brief, pages 4 through 14) that Schneller has been overruled by subsequent cases. According to appellant (Brief, page 4), the Court of Customs and Patent Appeals (CCPA) overruled Schneller in In re White, 405 F.2d 904, 906, 160 USPQ 417, 418 (CCPA 1969) by stating "[o]f course, if the appealed invention is unobvious, there can be

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[1]The examiner's rationale for the rejection tracks the reasoning used by the court which is as follows:

> While his [Schneller's] invention *can* be practiced in the forms ABCX or ABCY, the greatest advantage and best mode of practicing the invention as disclosed is obtained by using both inventions in the combination ABCXY. His first application disclosed ABCXY and other matters. He obtained a patent claiming BCX and ABCX, but *so* claiming these combinations as to cover them *no matter what other feature is incorporated in them*, thus *covering effectively ABCXY*. He now, many years later, seeks more claims directed to ABCX *and ABCXY*. Thus, protection he already had would be extended, albeit in somewhat different form, for several years beyond the expiration of his patent, were we to reverse. Schneller, 397 F.2d at 355-56, 158 USPQ at 216.

no double patenting." In White, the CCPA made such statement in connection with nonobviousness under 35 U.S.C. § 103, and not in connection with same invention double patenting under 35 U.S.C. § 101 or the judicially-created, obviousness-type double patenting. The Schneller decision never mentioned "nonobviousness" type double patenting, and the White decision was not addressing the same.[2] Thus, the Court had no need to overrule that which it had not created.

Appellant argues (Brief, page 4) that the Court sitting en banc in In re Vogel, 422 F.2d 438, 441-42, 164 USPQ 619, 621 (CCPA 1970) overruled prior CCPA decisions, such as Schneller, to the extent that the prior decisions were inconsistent therewith. Schneller was not mentioned in Vogel.

Although the subsequent case of In re Kaplan, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986) dealt with an obviousness-type double patenting rejection, it does not support appellant's arguments (Brief, page 4) because the Court never

[2]The so-called "nonobviousness" type of double patenting was a creation of the U.S. Patent & Trademark Office. See Manual of Patent Examining Procedure (MPEP) § 804 (6th ed., Jan. 1995), pages 800-15 and 800-16. The latest edition of the MPEP has dropped "nonobviousness" from the description of the Schneller decision.

mentioned Schneller.

Thus, appellant's arguments to the contrary notwithstanding, Schneller did not create a third type[3] of double patenting rejection (i.e., nonobviousness-type double patenting rejection) (Brief, pages 5 and 6).

Appellant argues (Brief, page 11) that "in *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 23 U.S.P.Q.2d 1839 (Fed. Cir. 1992), the Federal Circuit reiterated that 'same invention' and 'obvious-type' are the only recognized bases for a double patenting rejection." We agree with appellant's argument. Schneller fits within the latter type of double patenting rejection, and a "*Schneller*-based double patenting [rejection] is legally viable" (Brief, page 6).

Appellant argues (Brief, page 12) that "[i]f *Schneller* was good law, why did the U.S.P.T.O. fail to apply it between 1970 and 1994?" The mere fact that the Office failed to rely

[3]As indicated supra, the judicially-created, obviousness-type double patenting and same invention double patenting under 35 U.S.C. § 101 are the only types of double patenting rejections.

on Schneller until it was addressed in the 6th edition of the MPEP does not affect the use of Schneller as a basis for instituting a double patenting rejection when the facts in an application support such a rejection. When Schneller is properly applied, it will not "cast doubt over the validity of an untold number of issued patents, create disputes, and invite litigation" (Brief, page 13).

According to appellant (Brief, page 14), "[t]he second step of the *Schneller*-based double patenting analysis inquires whether there was a reason why an applicant was prevented from presenting the later-examined claims in the prior application." Appellant argues (Brief, page 14) that he "was indeed prevented from doing so by operation of Title 37, Code of Federal Regulation, section 1.141" which "prevents an applicant from claiming two or more 'independent and distinct' inventions in a single application."

A limitation-by-limitation comparison of the claims on appeal to the claims in the patent is needed to determine whether the two sets of claims present "independent and distinct" inventions. The examiner has not made a "side by

side comparison of the reference and application claims." See MPEP § 804 II B(2), page 800-21. Notwithstanding the lack of such an analysis by the examiner, the Court has indicated that appellant should establish that "the invention claimed in his patent is independent and distinct[4] from the invention of the appealed claims." Schneller, 397 F.2d at 354, 158 USPQ at 214. Accordingly, appellant argues (Brief, pages 16 and 17) that:

> It is clear that the appealed claims and the claims of the '131 patent do not form a single general inventive concept.[15] For example, the appealed recording claims relate to an apparatus and method of *producing a signal used for forming a record disc*. In contrast, claims 1-6 of the '131 patent recite an apparatus for *playing a record disc*, and claims 7-12 of that patent recite a method for *playing a record disc*. Clearly then, an apparatus and method for producing signals that are used to *form a record disc* and an apparatus and method for *playing a record disc* do not form a single general inventive concept. A recording device and method produce signals used for storing information on the record disc. In contrast, a playback device and method is directed to a

[4]In other words, a determination has to be made whether there is a "patentable difference" or a "patentable distinction" between the claims of the patent and the claims on appeal. General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1278-79, 23 USPQ2d 1839, 1844 (Fed. Cir. 1992).

different general inventive concept -- *i.e.*, the recovery of information stored on the disc.

The different general inventive concepts claimed in the appealed recording claims and the claims of the '131 patent are further exemplified by the disparate language recited in those groups of claim[s]. For example, the apparatuses and methods recited in the appealed recording claims are directed to devices and steps for receiving a video signal to be recorded and an audio signal to be recorded. Clearly, no such devices or steps are required in playing back information from a disc.

Because the appealed recording claims recite a general inventive concept different from that of the claims of the '131 patent, Applicant was prevented, by operation of 37 C.F.R. § 1.141 (1985), from presenting the appealed recording claims for examination during prosecution of the '131 patent in 1985-86. Thus, step 2 of the *Schneller*-based double patenting test is not satisfied with respect to the appealed recording claims, and the rejection of those claims should be withdrawn.

Similarly, the appealed playback claims (Claims 45, 46, 50, 51, 54, 56 and 58) recite apparatuses and methods relating to the reproduction of information from a disc. The subject matter of the appealed playback claims forms a general inventive concept different from that of the inventions defined by the claims of the '131 patent for the following reason: Each of the appealed playback claims recites a device or step for audio normalizing a received video/audio signal. The general inventive concept defined by the appealed playback claims allows the signal output from the devices and methods claimed therein to utilize the full dynamic range of an audio circuit. That same general inventive concept is not present in any of

the claims of the '131 patent.

A limitation-by-limitation comparison of the independent claims in the patent to the independent claims in the application is provided infra. To aid in this comparison, the following alphabetical designation has been provided for each signal and element that is claimed in both the patent claims and the application claims:

CLAIMED SIGNAL OR ELEMENT	ALPHABETICAL DESIGNATION
1. Video signal 35	A
2. Audio signal 21	B
3. Memory 31	C
4. Adaptive Delta Demodulator 23	D
5. Low-Pass Filter 51	E
6. Video Normalizer 55	F
7. Summer 59	G
8. Video/Data Output Signal 61	H
9. Disc Mastering Machine/Disc Reproduction Apparatus	I
10. Video/Data Input Signal 65	J
11. Data Normalizer 67	K
12. Memory 77	L
13. Adaptive Delta Demodulator 99	M
14. Analog Audio Output Signal 101	N

15. Video Output From Disc Reproduction Apparatus	O
16. Chroma Burst Timing Signal 72	P
17. Vertical Blanking Signal 85	Q
18. Horizontal Blanking Signal 87	R
19. Playback Apparatus (Audio/Video)	S
20. Data Flag Signal 73	T
21. Sequence Controller 69	U
22. 7.2 MHZ Enable Signal 75	V
23. Clock Generator 71	W
24. AND gate 83	X
25. Squelch signal 103	Y
26. Record Disc	Z

In the following limitation-by-limitation comparison of independent claims 1, 6, 7 and 12 in the patent to independent claims 42, 45, 53 through 59 and 61 in the application, the above-noted alphabetical designations are used for each of the claimed signals or elements. A bold-typed alphabet in the application claims indicates that the signal or element is not in the patent claims:

U.S. PATENT NO. 4,583,131	APPLICATION CLAIMS
Claim 1 - IJLMNOSZ	Claim 42 - **ABCFG**
Claim 6 - IJLMNOPQRSZ	Claim 45 - IJ**K**LMZ
Claim 7 - IJLMNOSZ	Claim 53 - **ABCFG**
Claim 12- IJLMNOPQRSZ	Claim 54 - IJ**K**LZ
	Claim 55 - **ABCFG**
	Claim 56 - IJ**K**LMZ
	Claim 57 - **ABCFG**
	Claim 58 - IJ**K**LZ
	Claim 59 - **ABCDEFG**
	Claim 61 - **ABCEFG**

From the comparison, it is clearly seen that none of the limitations of application claims 42, 53, 55, 57, 59 and 61 (directed to method and apparatus for producing a signal used for forming a record disc) is found in patent claims 1, 6, 7 and 12 (directed to method and apparatus for playing a record disc). Inasmuch as our analysis of these claims agrees with appellant's arguments, we find that appellant has established that the invention claimed in his patent is "independent and distinct" from the invention of the appealed claims 42, 53, 55, 57, 59, 61 and the claims that depend therefrom. In other words, the patent claims and the application claims are patentably distinct inventions.

Each of the independent application claims 45, 54, 56 and 58 includes an audio normalizer for "adjusting a level of said video/data signal to produce a normalized signal which utilizes a full dynamic range of audio circuitry." The examiner has not explained how the application claims with this feature could have been presented at the time of prosecution of the patent claims, or how this claimed subject matter is "covered" by the patent claims no matter what other feature is incorporated in them. It would have been equally

helpful for an explanation by the examiner as to why no other evidence of obviousness was needed beyond the claims of the patent. In the absence of such a showing or a convincing line of reasoning by the examiner, we agree with the appellant that the added feature in these application claims "is not present in any of the claims of the '131 patent. . . ." and that these claims are "independent and distinct" (i.e., patentably distinct) inventions (Brief, pages 16 and 17).

As a result of the patentable distinctness between the application claims and the patent claims, the examiner could have made a restriction requirement in the originally filed application.

DECISION

In summary, the judicially created doctrine of double patenting rejection of claims 42 through 51, 53 through 59 and 61 is reversed.

REVERSED

BRUCE H. STONER, JR., Chief Administrative Patent Judge	)	
KENNETH W. HAIRSTON Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)	

KWH:svt

Appeal No. 1999-0189
Application No. 08/344,691

STEPTOE & JOHNSON, LLP
1330 Connecticut Avenue, N.W.
Washington, D.C. 20036-1795

ATTENTION: Stuart T. F. Huang